

REMARKS

Claims 1-12 are pending. By this Amendment, the specification has been amended to correct a number of typographical errors, which are clear from a review of the specification. No new matter is involved.

The Office Action rejects claims 1-12 under 35 USC §103(a) as unpatentable over U.S. Patent 5,936,810 to Nakamoto et al. (hereinafter, "Nakamoto"). This rejection is respectfully traversed.

A showing of a suggestion, teaching, or motivation to modify a reference or to combine prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d at 1000, 50 USPQ2d at 1617. However, the suggestion to combine need not be express and "may come from the prior art, as filtered through the knowledge of one skilled in the art." Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489(Fed. Cir. 1997).

The basis of this rejection is a series of case law which is premised on routine optimization of result effective variables. However, for that case law to apply to a particular

situation, the Office must establish with evidence that the variable which is optimized is clearly (to one of ordinary skill in the art) a result effective variable.

Applicants respectfully submit that Nakamoto neither discloses nor suggests that the "total length of regions of the two electrode layers, one of which overlaps one of the surfaces of the magnetoresistive element, that are laid over the one of the surfaces of the magnetoresistive element" is a result effective variable.

Only Applicants disclose that the aforementioned total length is a result effective variable, i.e., if varied, it will change the output stability of the magnetoresistive device or the thin film head.

Because Nakamoto fails to disclose the aforementioned total length is a result effective variable, one of ordinary skill in the art would have no incentive, i.e., would not find it desirable, to focus on this feature and vary it to improve the output stability of the magnetoresistive device or the thin film head.

This case is similar to the situation in In re Yates, 211 USPQ 1149 (CCPA 1981) where the court concluded that the claimed degree of conversion was not recognized to be a result-effective variable, citing In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8-9 (CCPA 1977). The record did not contain a showing of any actual variations in the reaction conditions other than temperature variations.

The Office Action has not even alleged that a person of ordinary skill in the art at the time of the invention would have found it desirable, to focus on this claimed feature, and to vary it, to improve the output stability of the magnetoresistive device or the thin film head, let alone presented any evidence of record to support such an allegation. Accordingly, the Office Action fails to establish a prima facie case of obviousness of the claimed invention.

Moreover, because the Office Action fails to make out a prima facie case of obviousness, Applicant does not have to present evidence of the criticality of the claimed range to rebut the Office Action's assertions in this regard.

Even assuming (only for the sake of argument) that the Office Action demonstrated with evidence of record that varying the total length of the regions, as recited, was a known result effective variable (which it is not), Applicants respectfully submit that the criticality, including unexpected results, of the entirety of the claimed range of "smaller than 0.30 μm " and of "smaller than 0.15 μm " is set forth in Applicants' disclosure at least from page 21, line 8 to page 26, line 15; in Fig. 11; and in the specification from page 34, line 7 to page 35, line 7.

Claims 1, 4, 7 and 10, the four independent claims, all recite the "smaller than 0.30 μm " feature, and patentably define over Nakamoto for at least this reason. Dependent claims 2, 5, 8, 9 and 11 all contain a "smaller than 0.15 μm " feature, and are patentable for at least reciting this feature. Claims 3, 6 and 12, which depend, respectively, from claims 1, 4 and 10, all recite the "smaller than 0.30 μm " feature and are allowable for at least that reason.

Accordingly, Applicants respectfully submit that the subject matter of claims 1-12 is not obvious, and therefore is patentable, over the applied art.

Should the Examiner believe that there is anything further that is desirable to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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